



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,401	02/12/2002	Robert E. McCoy	P/79-4	7032

7590
PHILIP M. WEISS, ESQ.
WEISS & WEISS
300 Old Country Road
Suite 251
Mineola, NY 11501

03/07/2007

EXAMINER

FILIPCYK, MARCIN R

ART UNIT	PAPER NUMBER
----------	--------------

2163

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	10/074,401	MCCOY, ROBERT E.
	Examiner	Art Unit
	Marc R. Filipczyk	2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 December 2006.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8 is/are pending in the application.
 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,2 and 4-8 is/are rejected.
 7) Claim(s) 1,2 and 4-8 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 12 February 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
 5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

This action is responsive to Applicants RCE and amendment filed December 20, 2006.

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/20/2006 has been entered.

Amended claims 1, 2 and 4-8 are pending.

Priority

Claims Priority from Provisional Application 60/268,140 filed on February 12, 2001.

Claim Objections

Claims 1 and 7 are objected to because of the following informalities:

In the 12/20/06 response Applicant defined the “non-internet media buys” to be: “advertising which is not placed on the internet, which includes advertising on television, radio, and newspaper ads”, in support of page 4 of the specification. Examiner suggests replacing the

“non-internet media buys” with the defined segment above, to be consistent with the specification and to clearly claim the subject matter.

Claims 2, 4-6 and 8 depend from claims 1 and 7 respectively, comprise the same deficiencies and are therefore objected to on the same basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claims 1 and 7 do not involve transformation of article or physical object to a different state or thing, they merely recite comparing data. Further, independent claims 1 and 7 do not produce a useful, concrete, and tangible result, but merely compare data from a database and do not store any results. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claims 1 and 7 taken as a whole are directed to a mere method and system claim, i.e., are an abstract idea. Further system claim 1 does not comprise any hardware. Thus as explained above, claims 1 and 7 do not comprise a practical application hence are nonstatutory.

Since the claimed invention, as a whole, does not comprise a practical application as explained above, claims 2, 4-6 and 8 which depend from claims 1 and 7 respectively, are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 103(a) as best as the Examiner is able to ascertain as being unpatentable over Matsumoto et al (U.S. Patent No. 6,763,334).

Regarding claims 1 and 7, Matsumoto discloses a system and method for determining which non-internet ads direct which web clicks comprising (abstract):

a database comprising information about a user's non-internet media buys (fig. 1, item 15, col. 7, lines 4-56).

(Note: mailing magazine is one example of non-internet media buys)

an index log file optionally comprising a user's IP address (fig. 2, item 62, col. 8, lines 53-64);

said system comparing information from said first database with information from said index log file to determine which of said non-internet ads generated said web clicks (col. 10, lines 8-12);

and wherein the user's non internet buys comprises:

date and time of advertising, type of advertising, location of ad and expiration date of the ad (col. 7, lines 24-40 and col. 6, lines 59-64).

Matsumoto does not expressly teach a second database for storing user's IP address, but does store user's referrer log showing all referring pages from which the user is led to entrance page and also optionally stores the user's IP address in the index log file (62). Note, the user's IP address does not have to be stored because Matsumoto system uses an index URL embedded in the ad which allows for the monitoring of the user's access induced by the advertisement hence the actions of the user are known without the need for user's IP address, however, optionally user's IP address may be stored (col. 8, lines 53-63).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to store user's IP address and referrer log in a second database in the Matsumoto system by simply modifying the index log file (62) to be implemented as a database. One would be motivated to use a second database instead of an index log file to easier manipulate the data stored in the index log file.

Regarding claims 2 and 8, Matsumoto discloses the system further comprises a report that shows which ads generated the web clicks (col. 9, lines 61-65).

Regarding claim 4, Matsumoto discloses the information about a user's media buys further comprises demographics of the ad (col. 6, lines 59-63).

Regarding claim 5, Matsumoto discloses the information about a user's media buys further comprises cost of the ad (col. 5, lines 22-29).

Regarding claim 6, Matsumoto discloses a report that shows which of the web clicks do not correspond to an ad (col. 9, line 61 to col. 10, line 20).

Response to Arguments

Applicants arguments filed December 20, 2006 have been fully considered but they are not persuasive. The arguments and responses are listed below:

Note, Applicant's Remarks section consists of 4 unnumbered pages.

Applicant argues on page 1 of the 12/20/06 response that "non-internet media buys" is definite and is defined on page 4 of the specification.

In the 12/20/06 response Applicant defined the "non-internet media buys" to be: "advertising which is not placed on the internet, which includes advertising on television, radio, and newspaper ads". Examiner suggests replacing the "non-internet media buys" with the defined segment above, to be consistent with the specification and to overcome the present objection.

In the 12/20/2006 Applicant does not clearly argue on top of page 4 his position regarding the prior art or Examiner's office action however an argument is raised with regard to cancelled claim 3 whose subject matter was amended to claim 1, regarding the location of non internet advertisement.

Examiner notes that the newly amended features in claim 1 use "comprising" which does not necessitate that all the limitations be present. However, the cited paragraphs provided in the rejection above disclose all the claimed features including users demographics with respect to the claimed location of advertisement.

Below are some of Examiner's past copied and pasted remarks with respect to Applicant's previous responses and arguments relevant to the pending office action.

'Applicant argues on page 4 of the 11/17/05 response that Matsumoto does not teach "which non-internet advertisements generated a web click".

Examiner disagrees. First, it should be clear to one of ordinary skill that Matsumoto's mailing magazine and the like (col. 7, lines 4-9) fall under non-internet media buys and are/include non-internet type advertisements, as claimed. This data is later collected and the response to advertisements is measured (col. 10, lines 8-30). For better understanding of Matsumoto, please also refer to the passages cited in the rejections including col. 8, lines 25-65.

Examiner notes previous arguments filed 1/13/05 and Examiner's responses of record:

Applicant argues on page 5 that "Matsumoto does not teach or make obvious a second database comprising a user's IP address. Further Matsumoto does not teach or make obvious that the system compare information from the first database with information from the second database to determine which of the advertisements generated the web clicks.

Examiner disagrees. As stated in the rejection, Matsumoto teaches storing an index log file comprising a user's IP address (col. 8, lines 32-62). Even though Matsumoto does not explicitly claim the index file is a "second database", it is well known to one of ordinary skill that a database comprises a file and records for a number of functions, and it is clear that the index of the log file could be used for a number of functions, just as a database, hence, Examiner maintains his view that a simple modification or specific implementation of the index log file is equivalent to a database, as stated in the rejection. Applicants are reminded that arguments need to be supported by evidence. Second, naturally Matsumoto compares (analyzes) data from the first database and index log file to determine what advertisements caused users to perform specific actions (see rejection above and col. 8, lines 53-63 and col. 9).

No other arguments have been raised, thus with respect to all the pending claims 1, 2 and 4-8, Examiner respectfully traverses Applicants assertion based on the discussion and rejection cited above.

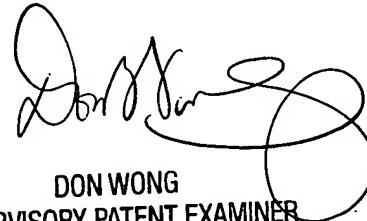
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF
February 23, 2007



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100